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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 09/960,008 | 09/21/2001 | Linda Morales | 13837RRUS02U(NORT0103) | 4221 |

7590 07/27/2005

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EXAMINER

WONG, WARNER

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2661

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/960,008 | Applicant(s) MORALES ET AL. | |
| | Examiner Warner Wong | Art Unit 2661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>21-Sep-2001</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-15, 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Grob (6,894,994).
2. Regarding claim 1, Grob ('994) describes a wireless communications system communicating packet data bearer traffic between a Mobile Station (MS) and a CDMA/IS-2000 (first type) system Base Station (BS) (fig. 5, 6A), where it may determine if a handoff is required to a High Data Rate (HDR)/1xEV (second type) system BS (fig. 5, 6A) and exchange handoff-related messages (lines 17-35, col. 26, lines 18-24).
3. Regarding claim 2, Grob ('994) describes that either the IS-2000 (first) BS or the HDR/1xEV (second type) BS may initiate handoffs (col. 24, lines 23-26).
4. Regarding claims 3, 6 and 8, Grob ('994) describes that the (first) CDMA/IS-2000 (col. 24, lines 17-35, col. 26, lines 18-24) BS or a HDR/1xEV (col. 23, lines 54-55) BS communicates bearer traffic with the MS.
5. Regarding claims 4-5, Grob ('994) describes the handoffs determination may be from a CDMA/IS-2000 BS to a HDR/1xEV BS (col. 24, lines 23-26).

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6. Regarding claims 7 and 9, Grob ('994) describes the handoffs determination may be from a HDR/1xEV BS to a CDMA/IS-2000 BS (col. 24, lines 23-26).

7. Regarding claim 10, Grob ('994) describes that the (required) handoff (messages) are communicated similar to that of handoffs between IS-95 and AMP systems (col. 24, lines 33-35).

8. Regarding claim 11, Grob ('994) describes the exchange of handoff messages includes sending a message from a CDMA/IS-2000 (first) BS to a HDR (second) BS (lines 17-35, col. 26, lines 18-24).

9. Regarding claim 12, Grob ('994) describes the exchange of handoff messages includes sending (another) message from the HDR (second) BS to the CDMA/IS-2000 (first) BS (lines 17-35, col. 26, lines 18-24).

10. Regarding claim 14, it is inherent that the message exchanges between the first BS and the second BS are done over a (network or air) link.

11. Regarding claim 15, Grob ('994) describes the handoff mechanism between the two systems is similar to the handoff between IS-95 and AMP (analog) systems, which may be a hard handoff (column 24, lines 33-35).

12. Regarding claim 24, Grob ('994) describes a hybrid packet-data (packet-switch) system (inherent with storage medium article containing instructions) (fig. 5, col. 9, lines 55-61) with a (first) CDMA/IS-2000 (protocol) BS that exchanges signaling with MS (fig. 6A), determines if a (required) handoff to a (second) HDR (protocol) BS (fig. 6A), and exchanges handoff-related messages with the HDR (second) BS (fig. 6A, col. 24, lines 17-35, col. 26, lines 18-24).

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13. Regarding claims 25 and 27, Grob ('994) describes a BS can be within a CDMA/IS-2000 system or HDR/1xEV system, where it (with instructions) communicates IS-2000 or HDR/1xEV signaling with the MS (fig. 5, 6a-c; col. 3, 1-5; col. 9, lines 55-61; col. 26, lines 18-24).

14. Regarding claims 26 and 28, Grob ('994) describes the (first) CDMA/IS-2000 or HDR/1xEV BS (with instructions) which will determine the (required) handoffs from the IS-2000 BS to a HDR/1xEV BS or vice versa (fig. 5, 6a-c; col. 24, lines 17-35, col. 26, lines 18-24).

15. Regarding claim 29, Grob ('994) describes the system (article containing instructions) to exchange (send) message from the CDMA/IS-2000 (first) BS to the HDR (second) BS for a (required) handoff.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grob ('994) in view of Jiang ('457).

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18. Regarding claim 13, Grob ('994) describes the exchange of handoff messages between the CDMA/IS-2000 (first) BS to the HDR (second) BS being similar to a handoff between the IS-95 and AMPS systems (lines 17-35, col. 26, lines 18-24).

Grob ('994) fails to describe a further message from the first BS to second BS.

Jiang ('457) describes a system with a direct connection (fig. 3, #160) between 2 different protocol BS which includes a further confirmation (directed to) hand-off message from (first) BS to (second) BS (fig. 5, #f).

It would have been obvious to one of ordinary skill in this art at the time of invention by applicant to modify the system of Grob ('994) to support the call processing of Jiang ('457) via a direct interface between the BS, including a further Begin Forward Traffic (further message indicating MS directed to handoff) message, to lessen the chance of a call being dropped due to timing requirements.

19. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang ('457) in view of Grob ('994).

20. Regarding claim 16, Jiang ('457) describes an apparatus with a source CDMA (first) BS using a first protocol (fig. 3, #118), has a direct interface (fig. 3, #160) to another (second) BS using a different protocol (fig. 3, #144), and has subunits of Call Control, SDU and ICF (controller) (fig. 3, #120, 122, 124) where the controller may exchange handoff-related messages with the second BS for a handoff (col. 3, 1-5; col. 9, lines 55-61).

Jiang ('457) fails to describe a packet-switching support system such as CDMA/IS-2000/HDR/1xEV.

Grob ('994) describes a packet-switch supporting CDMA/IS-2000/HDR/1xEV systems including BS (col.24, lines 18-20; col. 26, lines 18-22).

It would have been obvious to one of ordinary skill in this art at the time of invention by applicant to upgrade the CDMA network system of Jiang ('457) to support packet-switching with CDMA/IS-2000/HDR/1xEV systems of Grob ('994) due to evolutions/industry demands.

21. Regarding claims 17 and 18, Jiang ('457) describes an apparatus wherein the subunits of Call Control, SDU and ICF (controller), and may send and receive (exchange) messages between the first and second BS for a soft handoff (fig.3 & 4).

Jiang ('457) fails to describe the controller supporting hard handoff and IS-2000 format.

Grob ('994) describes a hybrid system including a CDMA/IS-2000 format system (with controller) which supports handoffs similar to that between IS-95 and AMPS systems (hard handoffs) (fig. 5, 6a-c; column 24, lines 17-35, col. 26, lines 18-24).

It would have been obvious to one of ordinary skill in this art at the time of invention by applicant to upgrade the CDMA network system of Jiang ('457) to a CDMA/IS-2000) system and include a greater handoff support of hard handoffs by Grob ('994).

22. Regarding claims 19 and 20, Jiang ('457) describes a CDMA system where first and second BS use different protocols (col. 9, lines 55-61).

Jiang ('457) fails to describe that the second BS and controller support HDR.

Grob ('994) describes a hybrid system with a HDR/1xEV system, including a HDR/1xEV (second) BS and controller (fig. 5 & 6).

It would have been obvious to one of ordinary skill in this art at the time of invention by applicant to build the CDMA network system of Jiang ('457) and include HDR/1xEV support of Grob ('994) for a greater wireless communications support.

23. Regarding claim 21, Jiang ('457) describes the controller may send a Handoff (HO) Request messages to the second (fig. 5, #b).

24. Regarding claim 22, Jiang ('457) describes the controller may receive (exchange) handoff-related messages from the second BS for a handoff (fig. 5, #b).

25. Regarding claim 23, Jiang ('457) describes the controller may send a Begin Forward Traffic (further message indicating MS directed to handoff) message from the first BS to the second BS (fig. 5, #f).

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

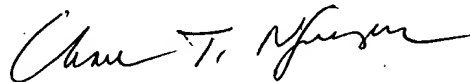
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Warner Wong whose telephone number is 571-272-8197. The examiner can normally be reached on 6:00AM - 3:00PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Warner Wong *WW*
Examiner
Art Unit 2661



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